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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,595	02/06/2002	Van Miller	6164-47	5448

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EXAMINER

SORKIN, DAVID L

ART UNIT

PAPER NUMBER

1723

DATE MAILED: 09/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/066,595	MILLER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David L. Sorkin	1723	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                              | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>04/17/02</u> | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to a method of manufacturing a confection having layers of different colors, classified in class 426, subclass 249.
  - II. Claims 12-15, drawn to mixer with injection port, classified in class 366, subclass 167.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the method could be practiced without the mixer, or with a different mixer. The independent method claim (claim 1) does not recite a mixer or mixing. The mixer could be used to mix materials other than those required by the method.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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5. During a telephone conversation with Donald Hewson on 17 September 2003 a provisional election was made without traverse to prosecute the invention of Group II, claims 12-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Objections***

7. Claim 15 is objected to under 37 CFR 1.75(c) as being an improper dependent claim. Claim 15 reads "The mixer of claim 11..."; however, claim 11 is directed to a method. As stated in MPEP § 608.01(n)(II), "Any claim which is in dependent form but which is so worded that it, in fact is not, as, for example, does not include every limitation of the claim from which it depends, will be required to be *canceled* as not being a proper dependent claim". In the instant case, it appears that claim 15 should depend from claim 12. For the purpose of consideration with regard to the prior art, the examiner will evaluate claim 15 as if it depended from claim 12.

#### ***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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9. Claims 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear if claim 15 is directed to a mixer or a method of manufacturing a confection. Claim 15 reads "The mixer of claim 11..."; however, claim 11 is directed to a method. It appears that claim 15 should depend from claim 12. For the purpose of consideration with regard to the prior art, the examiner will evaluate claim 15 as if it depended from claim 12.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 12, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Walker (US 2,516,436). Note the following regarding interpretation of the mixer claims:

a. The instant claims make reference to materials intended to be acted upon by the claimed mixer during an intended operation, such as "color syrup additive" and "tempered, lipid-based formulation". However, "expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim[s]" *Ex parte Thilbault*, 164 USPQ 666,667 (Bd. App. 1969). Likewise, "[i]nclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims" *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

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b. The instant claims recite several intended uses or operations of the mixer or parts thereof; however, "the manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself" *In re Casey* 152 USPQ 235 (CCPA 1967). Also, "recitation with respect to the manner in which the claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" *Ex parte Masham* 2 USPQ 1647 (Bd. Pat. App. & Inter. 1987).

Regarding claim 12, Walker ('436) discloses a mixer for mixing an additive to a formulation comprising a mixing body (17 in the embodiment of Figs. 1-3; 26 in the embodiments of Figs. 4-6) within which the additive is mixed with the formulation, and a feed tube (1,2) and an outlet tube (18 in the embodiment of Figs. 1-3; 8 in the embodiment of Figs. 4-6) leading into and away from said mixing body, respectively; a cyclically operating pump (5,7,9) connected to a reservoir for said additive (see col. 3, lines 35-56), and an injection port (6) located in said feed tube in a position so as to deposit discrete quantities of said additive into the center of said feed tube while the formulation flows therethrough (see Fig. 1 and 4-7; col. 3, line 43-56 and 72-73). The mixer is capable of being used in the manner discussed in claim 12. Discrete quantities of additive are discharge axially into the formulation at (6) as the formulation enters said mixing body through the feed tube at spaced intervals (see Fig. 1 and 4-7; col. 3, line 43-56 and 72-73). The formulation is evenly mixed with the additive and exits said mixer body at said outlet tube (see col. 3, lines 70-75). While, the reference does not disclose the same materials intended to be mixed as those mentioned in the claim, for

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example the reference does not disclose a "lipid based" material, the claim is still anticipated as explained in Notes "a" and "b" above. Regarding claim 14, said mixing body is a jacketed ribbon blender (see Figs. 6). While it is unclear what is being claimed in claim 15 as discussed above with regard to section 112, second paragraph, said cyclically operating pump is a proportional pump (see col. 3, line 43-56 and 72-73).

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Walker ('436) in view of Traelnes (US 3,604,690). The mixer of Walker ('436) was discussed above with regard to claim 12, from which claim 13 depends. The mixing body of Walker ('436) is cylindrical as required by claim 13 (see Figs. 1 and 2). However,

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Walker ('436) fails to disclose the combination of "a plurality of fingers directed radially inwardly from the circumference [of the mixer body], and a plurality of interposed circular discs each having a diameter less than the diameter of the mixing body mounted axially along the length of the mixing body". Trealnes ('690) discloses a cylindrical mixing body (1) having a plurality of fingers (the portions of 4 between notches 7) directed radially inwardly from the circumference thereof, and a plurality of interposed circular discs (3) each having a diameter less than the diameter of the mixing body mounted axially along the length of the mixing body (see Figs. 1 and 2). It is considered that it would have been obvious to one of ordinary skill in the art to have provided the mixing body of Walker ('436) with the discs and fingers taught by Trealnes ('690), because Trealnes ('690) explains that such a provision yields the benefit of higher efficiency (see col. 1, lines 20-20-37). Additionally, Walker ('436) discloses that a variety of mixing means are suitable for the object of the invention (see col. 2, lines 30-37).

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

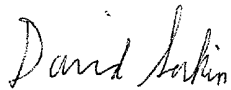
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David L. Sorkin whose telephone number is 703-308-1121. The examiner can normally be reached on 8:00 -5:30 Mon.-Fri..



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on 703-308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in cursive script that reads "David Sorkin".

David Sorkin